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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,474	07/14/2004	Stephen Neidle	1090-102	2378
23117	7590	11/18/2005	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			RAHMANI, NILOOFAR	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,474

Applicant(s)

NEIDLE ET AL.

Examiner

Niloofer Rahmani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claim 1 is currently pending in the instant application.

Priority

2. This application is a 371 of PCT/GB03/00102, filed on 01/14/2003.

3. ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gamage et al., " Synthesis and in vitro Evaluation of 9-Anilino-3,6-diaminoacridines Active Against a Multidrug-Resistant Strain of the Malaria Parasite Plasmodium falciparum", Journal of medicinal Chemistry, vol. 37, pages 1486-1494. Gamage et al. disclosed the instant claimed product on page 1489, table 1, where in X is 3,6-diNMe₂. Therefore, the instant claim is anticipated by Gamage et al.

4. ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1 is rejected under 103(a) as being unpatentable over Read et al., "Structure-based design of selective and potent G quadruplex-mediated telomerase inhibitors", Proceedings of the National Academy of Sciences of the United States of America, vol. 98, pages 4844-4849 in view of Gamage et al., "Synthesis and in vitro Evaluation of 9-Anilino-3,6-diaminoacridines Active Against a Multidrug-Resistant Strain of the Malaria Parasite Plasmodium falciparum", Journal of medicinal Chemistry, vol. 37, pages 1486-1494.

Determination of the scope and content of the prior art (MPEP §2141.01)

Read et al. on the page 4846, figure 2, line 2 disclosed analogous compounds where in J¹ and J² are both NH₂ and K=O.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant claim and the prior art compound is that the instant claim replaces one H of the prior art compound with a methyl. The Gamage et al. teaches that both NH₂ and methylate amino are optional choices for such compounds.

Finding of prima facie obviousness-rational and motivation (MPEP §2142.2143)

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One having ordinary skill in the art would be motivated to modify the compounds of Read et al. with a conventional alternative conversion step by adding a methyl group to NH_2 to obtain the instant compound.

5. Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1 is rejected under 103(a) as being unpatentable over McConnaughie et al., "Novel Acridine-Triazenes as Prototype Combilexins: Synthesis, DNA Binding, and Biological Activity", Journal of medicinal Chemistry, vol. 38, pages 3488-501 in view of Gamage et al., "Synthesis and in vitro Evaluation of 9-Anilino-3,6-diaminoacridines Active Against a Multidrug-Resistant Strain of the Malaria Parasite Plasmodium falciparum", Journal of medicinal Chemistry, vol. 37, pages 1486-1494.

Determination of the scope and content of the prior art (MPEP §2141.01)

McConnaughie et al. on the page 3491, scheme 3 disclosed analogous compounds where in J^1 and J^2 are both NH_2 and $K=O$.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant claim and the prior art compound is that the instant claim replaces one H of the prior art compound with a methyl. The Gamage et al. teaches that both NH_2 and methylate amino are optional choices for such compounds.

Finding of prima facie obviousness-rational and motivation (MPEP §2142.2143)

One having ordinary skill in the art would be motivated to modify the compounds of McConnaughie et al. with a conventional alternative conversion step by adding a methyl group to NH_2 to obtain the instant compound.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public

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PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

10/27/2005

NR



CELIA CHANG

PRIMARY EXAMINER

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